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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,529	11/03/2000	Hisashi Maejima	501.20289RC6	5458

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EXAMINER

PHAM, LONG

ART UNIT PAPER NUMBER

2823

DATE MAILED: 11/30/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action in Ex Parte R examination</b>	Control N . 09/704,529	Patent Under Reexamination MAEJIMA ET AL.	
	Examiner Long Pham	Art Unit 2823	

-- Th MAILING DATE of this communication app ars n the cover sheet with the correspondence address --

- a ☐ Responsive to the communication(s) filed on \_\_\_\_\_. b ☐ This action is made FINAL.  
c ☐ A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 3 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).** If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892. 3. ☐ Interview Summary, PTO-474.  
2. ☒ Information Disclosure Statement, PTO-1449. 4. ☐ \_\_\_\_\_.

Part II SUMMARY OF ACTION

- 1a. ☒ Claims 1,2 and 4-13 are subject to reexamination.  
1b. ☐ Claims \_\_\_\_\_ are not subject to reexamination.  
2. ☐ Claims \_\_\_\_\_ have been canceled in the present reexamination proceeding.  
3. ☐ Claims \_\_\_\_\_ are patentable and/or confirmed.  
4. ☒ Claims 1 and 4-13 are rejected.  
5. ☒ Claims 2 are objected to.  
6. ☐ The drawings, filed on \_\_\_\_\_ are acceptable.  
7. ☐ The proposed drawing correction, filed on \_\_\_\_\_ has been (7a) ☐ approved (7b) ☐ disapproved.  
8. ☒ Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of the certified copies have  
1 ☐ been received.  
2 ☐ not been received.  
3 ☒ been filed in Application No. 07/783,920.  
4 ☐ been filed in reexamination Control No. \_\_\_\_\_.  
5 ☐ been received by the International Bureau in PCT application No. \_\_\_\_\_.  
\* See the attached detailed Office action for a list of the certified copies not received.  
9. ☐ Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.  
10. ☐ Other: \_\_\_\_\_

cc: Requester (if third party requester)

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by DD148,997.

DD '997 teaches a wafer for forming an integrated circuit thereon, the wafer comprising (see figure 1 and the English translation of DD '997):

a main surface on which an integrated circuit is to be formed;

a substantially circular contour portion surrounding said main surface;

a curved positioning notch 3,4,5,6 formed in said circular contour portion;

and

connecting portions defined between said circular contour portions and said curved positioning notch, wherein said connecting portions are chamfered in a plane parallel to said main surface.

3. Claims 4-13 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. The addition of process claims 4-13 is considered as broadening of the invention because there were no process claims present in the original patent. The process claims 4-13 are directed to same subject matter as the non-elected claims of the original application and the applicant has failed to file a divisional application for the non-elected claims. See *In re Weiler, et al.* and *Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. and Int. 1989). A claim is broader in scope than the original claims if it

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contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

***Oath/Declaration***

The oath is defective because all inventors must sign the oath. See MPEP 1410.01.

***Allowable Subject Matter***

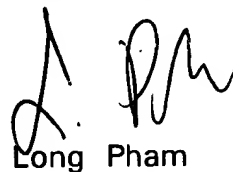
4. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Long Pham whose telephone number is 703-308-1092. The examiner can normally be reached on M-F, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on 703-308-4918. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-4082 for regular communications and 703-746-4082 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



Long Pham

Primary Examiner

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L. P.

November 16, 2001